

**REMARKS**

The Office Action mailed July 7, 2010 has been carefully considered. Within the Office Action, claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 138, 139, 141-157 and 226-228 were rejected. Reconsideration in view of the following remarks and accompanying clarifying amendments is respectfully requested.

**Obviousness-Type Double Patenting Rejection**

Claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 101, 102, 104-120, 138, 139, 141-157 and 226-228 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of US Patent 7,113,853 (“the ‘853 patent”). Applicant continues to point out that this rejection is improper because it does not indicate which claims in the ‘853 patent render specific claims in this application unpatentable. Since a double patenting rejection must be based on the claims of the ‘853 patent, such claims must be asserted, and specifically identified, in the rejection. The Examiner has failed to provide any particularized reason why any of the independent claims are not patentably distinct.

The Examiner asserts that the claims are not patentably distinct from one another because “they are both drawn toward checking the title history of a vehicle that are used to check previous owners, while the intended use is different, all the same information is collected and the uses for the collected information are deemed to be obvious variants as the exact same information is gathered and consulted.” As noted in the previous responses, this position is without legal or factual basis. The Examiner concludes that the “uses for the collected information are deemed to be obvious variants.” However, the Examiner fails to provide any rationale for this conclusion other than the mere conclusory comment. The Examiner has failed to offer any acceptable rationale for the conclusion of obviousness.

It is improper to disregard language recited in the claims. *Application of Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”); *In re Lowry*, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994) (“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.”); MPEP §§706.02(j); 2142; 2143.03. In setting forth a prima facie case, the Examiner may not opportunistically disregard certain claim language; rather, “[e]very word in a claim must be considered in judging the patentability of a claim against the prior art.” See *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, expressly recited method steps cannot be discarded from the claims.

The Examiner’s characterization of “determining... if said target record indicates an ownership transfer in which ownership of said vehicle is transferred from one owner to another owner...” as intended use is improper. This limitation is being positively claimed and is, therefore, not an intended use.

Furthermore, contrary to the Examiner’s assertion, in the present claims, information is not merely collected as asserted by the Examiner. Instead, the an ownership transfer is determined by determining if the target record indicates an ownership transfer based on the identified trigger record. In other words, the information is, in fact, manipulated.

Although data records are identified in both the ‘853 patent and the claims of the present application, the analysis of the data records is entirely different in the claims of the ‘853 patent and the claims of the present application. This analysis is set forth expressly as claim limitations and cannot be dismissed.

A comparison of Claim 1 of the ‘853 patent to Claim 1 of the present application illustrates this point. Claim 1 of the ‘853 patent recites the steps of identifying reliability issues

or identifying imported vehicles and displaying a file in the absence of a reliability issue or if the vehicle is not an import. Claim 1 of the present application, on the other hand, claims a method of determining whether an ownership transfer has occurred. The Table below compares Claim 1 of the '853 patent to Claim 1 of the present application (major differences between the claims are italicized).

Claim 1 from the '853 patent	Claim 1 of the present application
1. A method for generating and displaying information relating to a vehicle's history, comprising the steps of:	1. A method for generating information relating to vehicle histories of a plurality of vehicles comprising the steps of:
receiving a user request for information that relate to a particular vehicle;	identifying records in a database stored in a computer readable memory, said records being related to a vehicle and having information relating to the vehicle's history;
identifying records in a database that relate to the particular vehicle, said records containing data relating to the vehicle's history, said database having records of vehicles manufactured by a plurality of manufacturers;	identifying, by a processor of a computing device, <i>a target record in said records, said target record being at least one of a vehicle title record and a vehicle registration record;</i>
determining <i>whether said records include a reliability issue record containing information indicating that a reliability issue exists for the particular vehicle;</i>	identifying, by the processor of the computing device, <i>whether a trigger event record corresponding to said target record exists in said records, said trigger event record being a different record than the target record; and</i>
<i>if a reliability issue record exists for the particular vehicle, then displaying an electronically displayable reliability issue file;</i>	determining, by the processor of the computing device, <i>if said target record indicates an ownership transfer in which ownership of said vehicle is transferred from one owner to another owner based on said identifying step by processing said trigger event record.</i>
<i>if no reliability issue record exists, then determining whether said database should contain reliability issue information regarding the particular vehicle;</i>	
<i>and if said database should include reliability issue information regarding the particular vehicle, displaying an electronically displayable file related to the absence of a reliability issue for the particular vehicle.</i>	

This Table is not intended to compare Claim 1 of the '853 patent element-by-element to Claim 1 of the present application. This Table is provided merely to illustrate various differences

between Claim 1 of the '853 patent and Claim 1 of the present application. In general, these claims are associated with entirely different processes: Claim 1 of the '853 patent is directed to determining reliability issues for a particular vehicle while Claim 1 of the present application is directed to determining whether an ownership transfer has occurred. The steps of each claim are also entirely different. For example, Claim 1 of the present application includes the following limitations that are patentably distinct from any limitations appearing in any claim of the '853 patent: "determining, by the processor of the computing device, if said target record indicates an ownership transfer in which ownership of said vehicle is transferred from one owner to another owner based on said identifying step by processing said trigger event record."

Regarding Claim 78, Claims 1-38 of the '853 patent fail to teach or suggest, *inter alia*: determining, by the processor of the computing device, if said target record indicates an ownership transfer in which ownership of said vehicle is transferred from one owner to another owner based on said identifying step by processing said trigger event record.

Regarding Claim 101, Claims 1-38 of the '853 patent fail to teach or suggest, *inter alia*: an ownership module adapted to identify a target record indicative of ownership of said vehicle, said target record being one of a vehicle title record and a vehicle registration record identify a trigger event record corresponding to said target record, and determine whether said target record indicates an ownership transfer in which ownership of said vehicle is transferred from one owner to another owner based on said identified trigger event record.

Regarding Claim 138, Claims 1-38 of the '853 patent fail to teach or suggest, *inter alia*: determining if said target record indicates an ownership transfer in which ownership of said vehicle is transferred from one owner to another owner based on said identified trigger event record.

Each of independent Claims 9, 13, 16, 19, 27, 30, 33, 38, 41, 44, 51, 54, 60, 63 and 69 also require an analysis of data records to determine whether an ownership transfer of the vehicle has occurred that is not taught or suggested by Claims 1-38 of the '853 patent as described above with reference to Claim 1.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). *See, e.g., In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998). Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent and when, as noted by the Examiner, the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. *See Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001). The analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Consequently, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) must be employed when making an obvious-type double patenting analysis and any conclusion of obviousness-type double patenting must be premised upon these factual determinations. In the instant case, the asserted obviousness-type double patenting rejection fails to discharge the burden of making clear (1) the differences between the inventions defined by the conflicting claims (i.e., a claim in the patent compared to a claim in the application) and (2) the reasons why a person of ordinary skill in the art would have concluded that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent. Further, when considering

whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

The Examiner's mere allegation that "they are both drawn toward checking the title history of a vehicle and are used to check previous owners" is insufficient to discharge the burden incumbent upon the Examiner, as generally described above, to set forth a factual and legal predicate in support of the asserted obviousness-type double patenting. The Examiner, moreover, improperly reduces all of claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 101, 102, 104-120, 138, 139, 141-157 and 226-228 to merely a "different intended use" to the claims of the '853 patent.

The Examiner appears to take the position, on page 10 of the Office Action, that "knowing the number of owners of a vehicle is old and well known in the art" and the Examiner cites, in support, "ads routinely note 'Clean one-owner!!'". However, the claims are directed to particular determinations of ownership transfer. An analysis, not taught or disclosed in the '853 patent or any other prior reference cited by the Examiner, must occur to determine whether an ownership transfer has occurred. An advertisement regarding the number of owners does not provide an enabling disclosure of an analysis that determines whether an ownership transfer has occurred.

Applicants accordingly submit that the Examiner has not set forth a factually or legally sufficient case of obviousness-type double patenting and Applicants respectfully request withdrawal of the obviousness-type double patenting.

Rejection under 35 U.S.C. § 101

Claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 138, 139, 141-157, and 226-228 stand rejected based on 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicants have amended the claims to recite that a processor of the computing device performs the method steps. Applicants have also amended claim 138 to expressly recite that the instructions are “computer executable”. Independent claim 138 has also been amended to recite a “tangible” medium.

Applicants point the Examiner to several decisions of the Board of Patent Appeals and Interferences in which the Board overturned an Examiner’s rejection based on 35 U.S.C. § 101, where the claims included limitations similar to those in independent claims 1, 78 and 138. In particular, Applicants point the Examiner to *Ex Parte Muller et al.*, Appeal No. 2010-004360, *Ex Parte Jung et al.*, Appeal No. 2009-008915, *Ex Parte Darrell*, Appeal No. 2009-006757 and *Ex Parte Kohda et al.*, Appeal No. 2009-006262.

As explained in *Ex Parte Muller et al.*, the law in the area of patent-eligible subject matter for process claims has recently been clarified by the Supreme Court in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010). The Supreme Court held that the term “process,” as used in 35 U.S.C. 101, does not categorically exclude business methods, and further explained that the machine-or-transformation test is unduly narrow, but can be instructive as a factor in determining whether the claimed processes are patent-ineligible abstract ideas.

Claims 1 and 78 both refer to a processor of a computing device in the body (i.e., not in the preamble) of the process claim limitations. As held in each of the above Board of Appeals decisions, the mere inclusion of an apparatus, such as a processor of a computing device, in the body of a process claim supports a finding that they are tied to an apparatus and therefore qualify as patent-eligible subject matter.

Further, it is noted that *Ex Parte Kohda et al.* further sets forth that “[b]efore we can determine whether the claimed processes are abstract ideas, the broadest reasonable construction of the claims must first be established.” (see page 7)(citing *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed. Cir. 1998)(“whether the . . . patent is invalid for failure to claim statutory subject matter under 35 U.S.C. § 101[ ] is a matter of both claim construction and statutory construction”). As discussed above, the Examiner has not evaluated every element of the claims. Accordingly, the Examiner’s proffered analysis under 35 U.S.C. § 101 is legally erroneous at least upon this ground and fails to discharge the requisite burden upon the Examiner.

Applicants accordingly request withdrawal of the claim rejections under 35 U.S.C. § 101 at least in view of the above.

#### Rejection under 35 U.S.C. § 103

The Examiner rejected claims 1, 2, 4-7, 9, 10, 15-33, 40-47, 49-60, 78-94, 138, 139, 141-157, and 226-228 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,989,144 to Barnett. This rejection is traversed.

Applicants note in particular that the Examiner failed to respond to Applicants arguments in the prior response regarding the rejection of the claims over Barnett. Applicants specifically request that the Examiner specifically respond to Applicants arguments.

The Examiner submits that Barnett teaches all the elements of each of the independent claims, except for “using the data to adjust ownership.” Independent claims 1, 78, 101 and 138, however, do not include this limitation. It appears that the Examiner is simply copying and pasting arguments from prior Office Actions without analyzing the presently pending claims.



The Examiner further submits that Barnett discusses salvage titles and that “it is old and well known in the art that a one-owner vehicle is more prized than one which has had multiple owners (for instance ads that claim “Clean-one-owner!”)”, and concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention “to use the method and system taught by Barnett for adjusting the price of vehicles as a vehicle sold as ‘salvage’ is worth much less than one without, a vehicle with ‘true mileage unknown’ (which would be recorded at a sale) is also worth less and further, a one owner vehicle can be worth more if only by perception.” Again, Applicants note that independent claims 1, 78, 101 and 138 do not include limitations regarding adjusting the price of vehicles.

Barnett describes a system and method for determining whether a discrepancy, such as a prior salvage title, inconsistent odometer readings, duplicate title, title with unknown mileage, etc., exists. Barnett, however, does not describe determining if an ownership transfer has occurred. Thus, the Examiner has not pointed to a teaching in Barnett for all of the limitations of the independent claims.

Furthermore, the Examiner has failed to provide an adequate reason for modifying Barnett - it is unclear to the Applicants how ads that claim “Clean-one-owner!” would lead one of skill in the art to the invention which determines if apparent ownership transfer are likely to be actual ownership transfers. The Examiner additionally asserts that Applicants admitted that it is prior art to know the number of owners of vehicle. Applicants, however, have not admitted that a computer system or computer-implemented method is prior art that determines whether an ownership transfer has occurred, as claimed. Instead, Applicants have repeatedly asserted that Barnett does not disclose performing this determination or how to perform this determination.

Yet further, one of skill in the art would not have a reasonable expectation of success based on this modification. The cited art fails to provide a discussion of how the likelihood of

an ownership transfer is determined from ownership records and the Examiner's bald assertions fail to make up for the deficiencies of Barnett and such broad conclusory statements, standing alone, are not "evidence" supportive of a *prima facie* showing. *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578 (Fed. Cir. 1993). In contrast, the present specification provides such a description. In particular, paragraph [0051] states: "... For example, situations involving duplicate titles, lien discharges, title error correction and owner relation/moving, result in new title/registration records where in fact no transfer in vehicle ownership has occurred. Therefore, simple counting of the title/registration records would not ensure accurate determination of the number of owners for a particular vehicle." That is, in the prior art, systems that simply counted the title/registration records resulted in errors. In the present specification, on the other hand, a detailed description of how the determination is made follows paragraph [0051]. Similarly, a very detailed description of determining the adjustment or value of the vehicle is described beginning at paragraph [0122].

Further, independent claims 1, 78, 101, and 138 each expressly recite the novel use of target records (which are title or registration records) and trigger event records to determine if a target record is likely to represent an ownership change. The prior art of record fails to teach or suggest the use of trigger event records in the claimed manner.

The Examiner asserts that there would be a reasonable expectation of success when using ownership data to check for previous owners. However, the independent claims require that the determination of ownership data be performed using target records and trigger event records. None of the cited art references disclose or suggest performing the determination using target records and trigger event records. Because the prior art references fail to even disclose target records and trigger event records, there can be no reasonable expectation of success that a determination of ownership transfer can be made with these same records.

Thus, the cited art fails to teach or suggest all of the limitations of independent claims 1, 78, 101 and 138. The dependent claims depend, directly or indirectly, from one of the foregoing independent claims. Applicants, accordingly, request withdrawal of the rejections under 35 U.S.C. § 103.

Conclusion

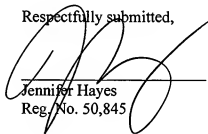
It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557.

Respectfully submitted,



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